

REMARKS

Reconsideration and withdrawal of the restriction requirement are respectfully requested in view of the remarks herewith.

The April 2, 2009 Office Action called for restriction from among the following:

Group I, claims 1-2, drawn to a compound or composition of a given general formula.

Group II, claims 3 and 7, drawn to a method of using a compound of a given general formula for controlling pests.

Group III, claim 4, drawn to a method of preparing a composition.

Group IV, claim 8, drawn to a plant propagation material.

According to the Office Action, Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, “they lack the same or corresponding special technical features”.

In response to the Restriction Requirement, the invention of **Group I, claims 1-2** drawn to a compound or composition of a given general formula, is elected, **with traverse**, for search purposes.

The Office Action alleges that the special technical feature linking the inventions of Groups I-IV does not constitute a special technical feature under PCT Rule 13.2, as it does not define a contribution over the prior art. In particular, the Office Action alleges that the claims of Groups I-IV lack a “special technical feature” that defines a contribution over Mrozik et al. (Bioorganic and Medicinal Chemistry Letters, 1995, 5(20), 2435-2440). PCT Rule 13.2 states that

“Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.”
(emphasis added).

Applicants hereby traverse the finding of a lack of a “special technical feature”.

The claims of Groups I-IV all recite the “technical feature” of a compound of formula I. Thus, the special technical features of the instant application relate to compounds or compositions of formula I and methods of using compounds, methods of preparing compositions, or plant propagation material treated with compounds of formula I. This technical feature is not taught by Mrozik et al.

Mrozik et al. allegedly relates to “Avermectins substituted in the 4'- and 4"-position having pesticidal properties and their use as pesticides”, which are “therefore made and used for the treatment of diseases or conditions, as those instantly claimed”. Applicants respectfully disagree with this over-simplification.

The present claims specifically require avermectin derivatives substituted in the 4'- or 4"-position to contain an oxygen containing linker between the saccharide and the substituent at the 4'- or 4"- position, with specific requirements for carbamate, thiocarbamate, carbonate or thiocarbonate derivatives emanating from the 4'- or 4"-position. The Office Action fails to state, and the Mrozik fails to show, the oxygen linked substituents, as are part of the special technical feature of the present invention.

Indeed, Mrozik relates to avermectin derivatives containing a nitrogen linked substituent at the 4'- or 4"- position, with specific requirements for amine, amide, sulfonamide, and urea substituents. Mrozik further contains one example of a carbamate linker, however the connectivity of the carbamate of Mrozik and the carbamates of the instant invention are distinct with respect to the avermectin backbone and thus distinguishable.

The pending claims recite compounds which are structurally distinct from those of Mrozik. Therefore, the pending claims do have a special technical feature which defines a contribution over Mrozik, and are therefore a contribution over the art cited as defined by PCT Rule 13.2.

In summary, the claims of Groups I-IV satisfy the inventive concept requirements of PCT Rule 13.1. Accordingly, reconsideration and withdrawal of the restriction requirement based on lack of inventive concept under PCT Rule 13.1 is respectfully requested.

In addition, enforcing the present restriction requirement would result in inefficiencies and unnecessary expenditures by both the Applicants and the PTO, as well as extreme prejudice to Applicants (particularly in view of GATT, a shortened patent term may result in any divisional or continuing applications filed). Restriction has not been shown to be proper, especially since

the requisite showings have not been made in the Office Action and there are relationships and special technical features between all of the pending claims. Indeed, the search and examination of each Group is likely to be co-extensive and, in any event, would involve such interrelated art such that the search and examination of the entire application can and should be made without. All of the foregoing, therefore, mitigate against restriction.

CONCLUSION

In view of the remarks herein, reconsideration and withdrawal of the restriction requirement are requested.

Early and favorable consideration of the application on the merits, and early Allowance of the application are earnestly solicited.

No fee is believed to be due. The Commissioner is authorized to charge any fee occasioned by this paper, or credit any overpayment in fees, to Deposit Account No. 50-0320.

Respectfully submitted,
MERIAL LTD.
FROMMER LAWRENCE & HAUG LLP

By:

Deborah L. Lu
Judy Jarecki-Black, Ph.D., J.D.
Reg. No. 44,170
Tel. No. (678) 638-3805
Fax No. (678) 638-3350

Thomas J. Kowalski
Reg. No. 32,147
Deborah L. Lu
Reg. No. 50,940
Tel. No. (212) 588-0800
Fax No. (212) 588-0500